

## REMARKS

At the outset, the Applicants wish to thank the Examiner for the thorough review and consideration of the subject application. The Non-Final Office Action of March 26, 2003, has been received and its contents carefully noted. Claims 1-12 have been amended merely to correct minor informalities and have not been narrow for reasons relating to patentability purposes. Claims 13-18 are newly added. Accordingly, claims 1-18 are pending in the present application.

In the Office Action claims 1, 3, 5, 7, 9, and 11-12 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 1-2 and 4-5 of co-pending Application No. 10/016,436; claims 1, 3, 5-7, 9, and 11-12 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 1-2, 4-5, and 17 of co-pending Application No. 09/802,828; and claims 1-12 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 3,309,437 issued to Harnett in view of U.S. Patent No. 4,127,391 issued to Koppelman combined with Great Brittan Patent No. 1,480,690 issued to Madley et al. ("Madley"). Applicants respectfully traverse these rejections and reconsideration is hereby requested.

### ***Provisional Obvious Type Double Patenting Rejection***

The Examiner provisionally rejected claims 1, 3, 5, 7, 9, and 11-12 under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over

claims 1-2 and 4-5 of co-pending Application No. 10/016,436. Applicants, respectfully traverse these provisional rejections and reconsideration is hereby requested.

A provisional obviousness-type double patenting rejection is identical to a non-provisional obviousness-type double patenting rejection, except that instead of a patent underlying the rejection, as in a non-provisional rejection, a patent application is underlying the rejection. Accordingly, the same standards, as discussed above, apply for a provisional rejection.

The requirements for a rejection under the judicially created doctrine of obviousness-type double patenting are similar to the requirements for establishing a *prima facie* case of obviousness under 35 U.S.C. § 103. However, the exception exists that the patent principally underlying an obviousness-type double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 USPQ (CCPA 1967). As set forth in M.P.E.P. § 804(II)(B)(1), the factual inquiries that are applied for establishing a *prima facie* case of obviousness under 35 U.S.C. § 103 are also employed when making an obviousness-type double patenting rejection.

Claims 1, 3, and 5 of the present invention are broadly directed towards an activated carbon foam. While claims 1-2 and 4-5 of co-pending Application No. 10/016,436 are not directed towards activated carbon foam. Additionally, claims 7, 9, and 11-12 of the present application are broadly directed towards a monolithic activated carbon filter element. However, claims 1-2 and 4-5 of co-pending Application No 10/016,436 are not directed towards a monolithic activated carbon filter element. The Examiner has merely alleged the claims are not patentably distinct from each other because the surface area of the instant claims would not be excluded from the claims of the co-pending application claims. The Examiner has not established a *prima facie* case of obviousness under 35 U.S.C. §103. Accordingly, Applicants respectfully

request the provisional obviousness type rejection be withdrawn as the claims are patentably distinct.

The Examiner provisionally rejected claims 1, 3, 5-7, 9, and 11-12 under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 1-2, 4-5, and 17 of co-pending Application No. 09/802,828. Applicants, respectfully traverse these provisional rejections and reconsideration is hereby requested.

Before consideration can be given to the issue of double patenting, there must be some common relationship and/or ownership of two or more applications. *See* MPEP § 804.

Applicants do not have a common relationship or ownership to Application No. 09/802,828 having a title "Iteration Terminating Using Quality Index Criteria of Turbo Codes."

Accordingly, Applicants respectfully submit any obviousness type-double patenting over Application No. 09/802,828 is improper.

***Rejections Under 35 U.S.C. §103***

The Examiner rejected claims 1-12 under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 3,309,437 issued to Harnett in view of U.S. Patent No. 4,127,391 issued to Koppelman combined with Great Brittan Patent No. 1,480,690 issued to Madley et al. ("Madley"). Applicants respectfully traverse these rejections and reconsideration is hereby requested.

Claim 1 is allowable over the cited references in that claim 1 recites a combination of elements including, for example, "said activated carbon foam produced from particulate coal exhibiting a free swell index ranging from about 3.5 to about 5.0, wherein said activated carbon

foam has a density ranging from 0.1 to about 0.8 g/cm<sup>3</sup>; and wherein said activated foam has an overall surface area of ranging from about 10 m<sup>2</sup>/g to about 25 m<sup>2</sup>/g.” None of the cited references either singly or in combination teaches or suggests at least these features of the claimed invention.

The Examiner has not meet the requisite burden in establishing a *prima facie* case of obviousness. In levying an obviousness rejection under 35 U.S.C. § 103, the Examiner has the burden of establishing (1) some suggestion or motivation to modify the reference or to combine reference teachings, (2) a reasonable expectation of success, and (3) that the prior art references, when combined, teach or suggest all the claim limitations. *See* MPEP § 2143 (8th Ed., Rev. Feb 2003).

The Examiner’s burden in levying an obviousness rejection is discussed above. The Federal Circuit recently emphasized the importance of evidencing the requisite motivation to combine references when rejecting claims based upon obviousness. *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002). In the present case, the Examiner has failed to make the requisite showing, as articulated in *Lee* and its predecessors, of a motivation to combine Harnett, Madley and Kirk-Othmer. Additionally, the references teach away, for example, Harnett specifically teaches a method that does not use mechanical pressure to form a carbon body, while Madley specifically uses mechanical pressure in forming briquettes. Given the references opposite teachings, one skilled in the art would not have been motivated to combine Harnett and Madley.

Further, even assuming *arguendo* that the references are properly combined, the combination fails to teach or suggest all of the claim features. Neither, Harnett, Koppelman, nor Madley teach or suggest activated carbon foam having an overall surface area of ranging from

about 10 m<sup>2</sup>/g to about 25 m<sup>2</sup>/g as required by claim 1. This is further evidenced by the fact this limitation was not addressed in the § 103 rejection.

Additionally, it appears that the Examiner is relying on official notice by stating, "the apparent density of 0.93 g/cc renders obvious the apparent density ranging from about about 0.1 to 0.8 g/cm<sup>3</sup>. The Examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art. *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970). As set forth in MPEP § 2144.03, if an applicant traverses an assertion made by an Examiner while taking official notice, the Examiner should cite a reference in support of their assertion. Accordingly, Applicants respectfully traverse all use of official notice and respectfully request a reference in support of the assertions. For at least the foregoing reasons, Applicants respectfully submit that claim 1 and claims 2-6, which depend from claim 1, are allowable.

Claim 7 is allowable over the cited references for at least the similar reasons as discussed above with respect to claim 1. Claim 7 recites a combination of elements including, for example, "an activated carbon foam produced from particulate coal exhibiting a free swell index ranging from about 3.5 to about 5.0, wherein said activated carbon foam has a density ranging from about 0.1 to about 0.8 g/cm<sup>3</sup> and an overall surface area ranging from about 10 m<sup>2</sup>/g to about 25 m<sup>2</sup>/g." None of the cited references either singly or in combination teaches or suggests at least these features of the claimed invention. Accordingly, for at least the foregoing reasons, Applicants respectfully submit that claim 8 and claims 9-12, which depend from claim 8, are allowable.

Claims 13 is allowable over the cited references for at least the similar reasons as discussed above with respect to claim 1. Claim 13 requires a combination of elements including,

for example, "heating swellable particulate coal in a mold to a first temperature ranging from about 300° C to about 700° C under a non-oxidizing atmosphere at a pressure ranging from about 25 psi to about 500 psi ... activating carbon foam by flowing an activation agent into the mold at a second temperature for increasing the first overall surface area ranging from about 10 m<sup>2</sup>/g to about 25 m<sup>2</sup>/g." None of the cited references either singly or in combination teaches or suggests at least these features of the claimed invention. Accordingly, for at least the foregoing reasons, Applicants respectfully submit that claim 13 and claims 14-18, which depend from claim 13, are allowable.

### **Conclusion**

Applicants believe that a full and complete response has been made to the pending Office Action and respectfully submit that all of the stated objections and grounds for rejection have been overcome or rendered moot. Accordingly, Applicants respectfully submit that all pending claims are allowable and that the application is in condition for allowance.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact the Applicant's undersigned representative at the number below to expedite prosecution.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,



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